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Serial Number: 09/893038   Dkt: 884.484US1 (INTEL)
Filing Date: June 27, 2001
Title: MOBILE CLIENT FOR SELECTING A SERVICE PROVIDER IN A MULTI-SERVICE PROVIDER NETWORK ENVIRONMENT
    (As Amended)
Assignee: Intel Corporation

REMARKS

This responds to the Office Action mailed on March 2, 2004. No claims have been amended for this Response. Based upon Applicant's arguments in support of patentability described below, Applicant respectfully requests reconsideration of the claims.

Title of the Application

The Examiner identified the title of the application as not descriptive of the invention to which the claims are directed. The title has been amended herein.

Submission of Formal Drawings

Three sheets of formal drawings for Figures 1-3 are submitted herewith. It is believed that the drawings are in compliance with 37 C.F.R. 1.84. No amendments were made to the drawings.

§102 Rejection of the Claims

Claims 1-10, 13-26, 28, 29 and 31 were rejected under 35 U.S.C. § 102(e) as being anticipated by Novakov (U.S. 6,571,103). Applicant does not admit that the Novakov patent is prior art to the present invention. Applicant respectfully reserves the right to swear behind the Novakov patent at a later date. At this time, Applicant chooses to distinguish the Novakov patent from the present invention. Thus, Applicant respectfully traverses these grounds for rejection.

Claims 1-10 are means-plus-function claims under 35 U.S.C. § 112, paragraph 6. MPEP § 2183 (Manual of Patent Examining Procedure, 8th Ed., Rev. 2, May, 2004) requires the Examiner to make a prima facie case of equivalence under 35 U.S.C. § 112, paragraph 6. However, Applicant respectfully submits that the Examiner has not analyzed claims 1-10 in accordance with how the functions of these claims are equivalent to the corresponding elements disclosed in the specification as is required by the MPEP § 2183. The applicant respectfully submits that the Novakov patent does not disclose equivalent elements to the corresponding elements disclosed in the specification under 35 U.S.C. § 112, paragraph 6.

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It is axiomatic that each word in a claims must be given weight when analyzing claim language. Applicant believes that many of the functions of claims 1-10 have not been viewed properly in light of the equivalent elements in the specification. For example, claim 1 recites a communication device first having "means for interrogating a plurality of wireless network access service providers ..." [Emphasis Added] The plurality of service providers are queried "to gather information related to service offerings thereof..." [Emphasis Added]

In the Novakov patent, there is only one wireless network access provider, and that is the Bluetooth® network. The GSM transceiver disclosed in Novakov is used for telephone use only. In column 4, lines 28-37 of Novakov describes the use of the GSM connection:

> The GSM radio unit 40 is used to establish a long range, cellular radio channel 46 according to the GSM standard.
>
> In the present sample embodiment, the mobile station 26 is actually a GSM mobile telephone. The controller and baseband module 34 and the GSM radio unit 40 perform all functions required for the standard GSM telephone operating mode. These functions and the necessary hardware are well known and are not the subject of the present invention.

Further, the Bluetooth® connection of the Novakov patent communicates with one Bluetooth® service provider and only negotiates a channel connection. The Novakov patent does not request any service offerings from the service providers since this would have to take place after the connection is negotiated.

Another means plus function clause which has not been given its proper weight describes a "means for obtaining a provider selection criterion associated with a user of said communication device..." [Emphasis Added] The Novakov patent does not collect any provider selection criterion since properties of the radio channel are all that are negotiated.

Another means plus function clause which has not been given its proper weight describes a "means for selecting a service provider from said plurality of wireless network access service providers to provide wireless access to a network for said communication device based on said provider selection criterion and said information." Again, the Novakov patent does not describe selecting between service providers based upon selection criterion. The Bluetooth® network of

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the Novakov patent is simply selected if the user doesn't want GSM. GSM is selected only if the user does not want Bluetooth®. This selection is not based on provider selection criterion and information. Further, the Novakov patent does not even gather provider selection information.

The Novakov patent merely provides a protocol for handshaking in a Bluetooth® environment to establish a connection with a single Bluetooth® base station. Although Novakov includes a GSM transceiver, this is merely for voice functionality. The Novakov patent does not state that the GSM transceiver is used for anything except voice.

In contrast to Novakov, claims 1-10 of the present patent application are focused on a plurality of service providers that are found locally (in hot spots) and the types of service each can offer. The communication device of claims 1-10 is designed to select from competing networks. Thus, the functions of claims 1-10 do not correspond to the elements of the Novakov patent. Since all the functions of claims 1-10 are not found in the single Novakov patent, the rejection under 35 U.S.C. § 102(e) is invalid. Applicant respectfully requests reconsideration of claims 1-10 and an indication of allowance for these claims.

Claims 13-21 are method claims directed at a method for procuring wireless access to a network for a communication device. Applicant respectfully traverse the rejection of claims 13-21 under 35 U.S.C. § 102(e) as being anticipated by the Novakov patent for the following reasons.

The method steps of claim 13 for example (but not by way of limitation) include limitations such as "selecting a service provider from said plurality of network access service providers based on said information and a selection criterion." As described above in more detail, the Novakov patent does not have a plurality of network access service providers to choose from and it does not have any selection criterion. The Novakov patent is managing rudimentary handshaking and channel negotiation. It isn't until after a channel connection is established does the claimed invention operate. Since all the elements of claims 13-21 are not found in the single Novakov patent, the rejection under 35 U.S.C. § 102(e) is invalid. Applicant respectfully requests reconsideration of claims 13-21 and an indication of allowance for these claims.

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Claims 22-25 are *Beauregard*-style claims for a computer readable medium into which a method is embedded. Again as described above more fully, claims 22-25 contain limitations not found in the Novakov patent. The method steps of claim 22 for example (but not by way of limitation) include limitations such as "interrogating a plurality of network access service providers for information relating to service offerings..." and "selecting a service provider from said plurality of network access service providers based on said information and a selection criterion." The Novakov patent does not have a plurality of network access service providers to choose from, it does not interrogate the plurality for service offerings and it does not have any selection criterion. Since all the elements of claims 22-25 are not found in the single Novakov patent, the rejection under 35 U.S.C. § 102(e) is invalid. Applicant respectfully requests reconsideration of claims 22-25 and an indication of allowance for these claims.

Claims 26, 28-29 and 31 are device claims for a communication device. Again as described above more fully, claims 26, 28-29 and 31 contain limitations not found in the Novakov patent. The elements of claim 26 for example (but not by way of limitation) include limitations such as an "interrogation function" which receives information and a "selection function" which selects based upon "provider selection criterion." The Novakov patent does not have a plurality of network access service providers to choose from and it does not have any provider selection criterion. Since all the elements of claims 26, 28-29 and 31 are not found in the single Novakov patent, the rejection under 35 U.S.C. § 102(e) is invalid. Applicant respectfully requests reconsideration of claims 26, 28-29 and 31 and an indication of allowance for these claims.

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§*103(a) Rejection of the Claims*

Claims 11, 12, 27 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Novakov in view of Pecen et al. (U.S. 6,466,804). Claims 11, 12, 27 and 30 are dependent upon the independent claims discussed above. Applicant believes they have established that the Novakov patent does not anticipate the independent claims upon which claims 11, 12, 27 and 30 depend. In reviewing the Pecen et al. patent, all the limitations missing from the Novakov patent are not provided by the Pecen et al. patent. For example, claims 11 and 12, taken with independent claim 1 upon which these claims depend, fail to describe such functions as a "means for interrogating a plurality of wireless network access service providers ..." and a means "to gather information related to service offerings thereof..." Also, for example, claims 27 and 30, which depend upon independent claim 26, include such limitations as "interrogation function" which receives information and a "selection function" which selects based upon "provider selection criterion." These limitations are also not found in Pecen et al. Since all the elements of claims 11, 12, 27 and 30 are not found in the combination of the Novakov and Pecen et al. patents, the rejection of these claims under 35 U.S.C. § 103(a) is invalid. Applicant respectfully requests reconsideration of claims 11, 12, 27 and 30 and an indication of allowance for these claims..

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Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 373-6904) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

NIKHIL M. DESHPANDE ET AL.

By their Representatives,

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Date July 1, 2004   By Daniel J. Kluth
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this ___1___ day of July, 2004.

KACIA LEE   Kacia Lee
Name   Signature